UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROCHIP TECHNOLOGY INC.,
Petitioner,

v.

APTIV TECHNOLOGIES AG,
Patent Owner.

U.S. Patent No. 11,681,643

Post Grant Review No. PGR2024-00011

PATENT OWNER'S REPLY IN SUPPORT OF THE MOTION TO STRIKE

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I. PETITIONER CANNOT IDENTIFY ANY BASIS IN THE PETITION FOR THE CHALLENGED NEW MATERIALS

The only issue before the Board in this Motion to Strike is whether Section IV.3.A.b of Petitioner's Reply, and that section's supporting evidence, should be stricken as improper new argument. Petitioner's Opposition (Paper 36) directs the Board's attention to other sections of its Reply, because Petitioner does not, and cannot, identify any basis in its Petition for the Section IV.3.A.b argument. Instead, Section IV.3.A.b "proceed[s] in a new direction with a new approach" compared to the Petition, and thus does not properly "respond" to the POR under the Trial Practice Guide. (Patent Trial and Appeal Board, Consolidated Trial Practice Guide (Nov. 2019) ("CTPG"), 74.)

Section IV.3.A.b advances a newly modified version of the Petition's prior art combination. (Mot., 3-5.) This section does not explain that the originally presented combination "would still work." (Opp., 4-5.) Instead, it clarifies that the combination would only work "*provided the mux reverts to a default state (viz., routing to the bridge) when a mode change occurs*"; and newly hypothesizes how the combination's crossbar could be directed to perform that reverting. (Reply (Papers 29, 30), 12-15 (emphasis added); EX1102, ¶¶52-55.) Petitioner's expert explains what is "required": a multitude of changes, including the addition of new circuitry, signals, and control logic, to the original prior art combination. (EX1102, ¶¶ 54-55; Mot., 3-5.) Petitioner does not argue in its Opposition that

these changes—which Petitioner characterizes as a "laundry list," Opp., 6—were in the Petition. There is no dispute that they are newly presented on reply.

II. THE CHALLENGED SECTION OF THE REPLY IMPROPERLY MODIFIES THE PETITION'S PRIOR ART COMBINATION

Petitioner denies that the challenged materials include new argument because they raise "no new grounds, prior art references, or combinations." (Opp., 6.) Not so: to meet the USB signal routing claim limitations, the Petition's obviousness grounds rely on an amorphous "POSITA's knowledge," which expands in the Reply to encompass the new circuit elements and behaviors described in Section III of the Motion. (*See* Mot., 3-5; Reply, 12-15.) This expansion is effectively new prior art that is not mentioned in the Petition nor in any of its prior art references. Yet, in Section IV.A.3.b of the Reply, it is relied upon to show how the mux could be modified to "reset[] to a default condition." (Opp., 7 n.2.) As explained in the Motion, this modification represents an improper "new approach" to the Petition. (Mot., 6-7; CTPG, 74.)

More broadly, a reply need not raise new grounds, prior art references, or combinations to be considered improper new argument. For example, in *MModal LLC v. Nuance Commc'ns, Inc.*, the Federal Circuit affirmed the Board that the Petitioner's Reply made "an impermissible new argument not sufficiently made in the petition" based on the same reference. Similarly, the Petition here failed to discuss the specific aspects of the alleged prior art on which the new argument

relies. *MModal LLC*, No. 2020-1693, 13 (Fed. Cir. Feb. 23, 2021) (non-precedential); *see also Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1367 (Fed Cir. 2015) (affirming the Board's rejection of a petitioner's "reliance, in its Reply submissions, on previously unidentified portions of a prior-art reference to make a meaningfully distinct contention."). Similarly, in *Arista*, the stricken reply argument was based on portions of testimony that, while part of the record, were not "relied upon," "specifically argued," or "explained" in the petition. *Arista Networks, Inc. v. Cisco Sys., Inc.*, IPR2016-00308, Paper 42, 13 (PTAB May 25, 2017). The reply in *Arista* was found non-responsive under 37 C.F.R. § 42.23(b) where it presented, as here, "a new mapping of the claims to the prior art in light of the gaps that Patent Owner pointed out in its Response." *Id*., 14. Even if Section IV.A.3.b of the Reply relies on aspects of "existing, industry standard USB protocols," *i.e.*, to revert to a default mux state, those aspects were not even mentioned in the Petition—let alone relied upon, specifically argued, or explained—and belong to improper new argument. (Opp., 7 n.2.)

In any event, USB protocols alone do not establish that the mux "reverts to a default state (*viz*., routing to the bridge) when a mode change occurs" and thereby sidesteps the dead-end problem. (Reply, 12-15; Opp., 7 n.2.) A mux does no such thing unless it is made to do so by its control signals, which "control mux routing". (*See* EX1013, ¶¶89, 234; EX1069, 495; EX1060; EX1068, 2.) To control the state

of the mux according to USB protocols, the POSITA would have had to provide the appropriate signals to the mux's control signals. But it was not until the Reply, in a belated attempt to fix the dead-end problem, that Petitioner suggested using USB signals to control a default state of the mux. (Reply, 12-15.) This represents a "meaningfully distinct contention" from the Petition, which did not articulate any relationship between the mux's control signals, or default state, and USB protocols or signals. *See Ariosa, supra* at 1367.

III. PETITIONER COULD HAVE REASONABLY ANTICIPATED THE DEAD-END PROBLEM

Petitioner argues, without any cited authority, that it could not have foreseen the dead-end problem because it would "create written description and enablement problems" by "requiring the prior art combination to solve purported problems that would exist in the Challenged Patent". (Opp., 1, 9.) Even if true, such problems would not excuse Petitioner's presentation of a defective prior art combination, particularly since Petitioner was on notice of the dead-end problem at least via its own expert's declaration. (*See* Mot., 8-9.) More fundamentally, Petitioner's premise is mistaken: for example, the Challenged Patent discloses that "the *Head Unit* controls the switching device via the USB Bridge hardware *or any other convenient means of control*," *e.g.*, by "requesting, commanding or otherwise knowing the phone is required to be in the USB Host mode and commanding the routing of the specific USB port the phone is attached to the USB Bridge."

(EX1011, 6:23-30 (emphasis added).) That is, unlike the Petition, the Challenged Patent discloses utilizing the head unit, not the bridge—which becomes disconnected from the downstream port in the Petition's proposed combination—to detect a mode requirement and control the switching device accordingly.

IV. PATENT OWNER IS UNFAIRLY PREJUDICED BY THE NEW ARGUMENT

Petitioner denies that Patent Owner is prejudiced by the new reply argument, because Patent Owner is entitled to a sur-reply and a deposition of Petitioner's expert. (Opp., 10.) But this is true of all current IPR proceedings, and Petitioner's position would render superfluous motions to strike new argument on reply. As the Trial Practice Guide recognizes, a party can be prejudiced by the need to address belated new theories during the oral hearing, and a motion to strike can be warranted in such situations. (CTPG, 81.) This prejudice is particularly acute here, where the oral hearing will span multiple complex technical arguments in a limited time period, and it is not cured by the opportunity for a sur-reply (even if accompanied by a new expert declaration) and a deposition. Moreover, Petitioner acknowledges prejudice in suggesting that Patent Owner must seek "alternative relief" in its sur-reply. (Opp., 10.) And, as unaddressed by Petitioner, the prejudice is not just to the Patent Owner, but to the Board, whose limited resources would be misspent on improperly presented issues.

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By: /Alex S. Yap/
Alex S. Yap
Reg. No.: 60,609
MORRISON & FOERSTER LLP
707 Wilshire Blvd., Suite 6000
Los Angeles, CA 90017
Email: AYap@mofo.com
Tel: 213-892-5200

Counsel for Patent Owner

Certificate of Service (37 C.F.R. § 42.6(e)(4))

I hereby certify that the attached PATENT OWNER'S REPLY IN SUPPORT OF THE MOTION TO STRIKE was served as of the below date on the Petitioner via e-mail (by agreement) to the following counsel of record:

Travis Jensen (Registration No. 60,087)
tjensen@orrick.com
T61PTABDocket@orrick.com
Jeremy Jason Lang (Registration No. 73,604)
jlang@orrick.com
PTABDocketJJL2@orrick.com
Orrick, Herrington & Sutcliffe LLP
1000 Marsh Road
Menlo Park, CA 94025-1015

Dated: February 19, 2025

/Alex S. Yap/
Alex S. Yap